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DEC - 1 2003

Paper No. 8

In re Application of :
Tommy Leo Myatt : DECISION ON PETITION
Application No. 09/610,196 :
Filed: July 5, 2000 :
Attorney Docket No. 5300-001 :

This is a decision on the petition filed by facsimile transmission on March 6, 2002 and resubmitted by facsimile transmission on May 29, 2002. Petitioner requests that the examiner's holding that this application stands abandoned for failure to file a proper and timely reply to the Office letter dated August 2, 2001 be withdrawn. The petition is being treated under 37 CFR 1.181 and no fee is required. However, petitioner requests that in the alternative, the application be revived pursuant to 37 CFR 1.137(b). It is noted that petitioner has authorized a charge against Deposit Account No. 50-0464 as may be necessary.

The petition to withdraw the holding of abandonment is denied.

It appears from the record that on August 2, 2001, a requirement to restrict this application by electing one of a plurality of patentably distinct inventions was mailed to petitioner at the correspondence address of record (i.e., to counsel of record). Counsel for petitioner alleges that counsel replied to this requirement by telephoning the examiner on August 20, 2001 and making an election consonant with the restriction requirement. This allegation is supported by contemporaneous notes made by counsel with respect to that telephone conversation, and records indicating that a telephone call was placed by counsel to examiner on that date. It further appears from the petition that the examiner telephoned counsel on February 20, 2002 to inquire "as to whether abandonment of the case was intended." Counsel states that this was the first time that counsel was aware that the oral election "had not been accepted."

Petitioner argues that there is no absolute requirement that an applicant submit all responses to all Office actions in writing, and that oral responses to restriction requirements are encouraged. Petitioner cites MPEP 812.01 in support of these propositions. Petitioner further argues that even where a restriction requirement is made in writing, a response thereto (i.e. an election) may be made orally, and cites MPEP 714.04 (*sic*, MPEP 713.04) in support of that proposition. Petitioner argues, alternatively, that even if the oral election was deemed to be defective for some reason, the examiner should have treated the oral election as a *bona fide* attempt to respond and taken action pursuant to 37 CFR 1.135(c), rather than holding the application to have become abandoned.

37 CFR 1.111 reads in pertinent part:

"Reply by applicant or patent owner to a non-final Office action.

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

...

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. ..."

37 CFR 1.104 reads in pertinent part:

" Nature of examination.

(a) Examiner 's action .

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated."

37 CFR 1.142 reads in pertinent part:

"Requirement for restriction.

" If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action."

37 CFR 1.143 reads in pertinent part:

"Reconsideration of requirement.

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor (See § 1.111).

MPEP § 812.01 is entitled "Telephone Restriction Practice" and states, in pertinent part:

"If an examiner determines that a requirement for restriction should be made in the application ... [T]hereupon, the examiner should telephone the attorney or agent of record and request an oral election However, no telephone communication need be made If the attorney or agent objects to making an oral election, or fails to respond, the usual restriction letter will be mailed and this letter should contain reference to the unsuccessful telephone call. ... "

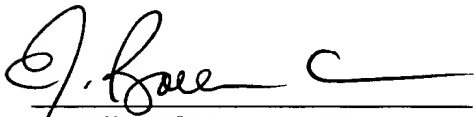
Consideration of these Federal Regulations and the section of the MPEP cited by petitioner, it is clear that petitioner's arguments are not persuasive. An applicant's ability to make a telephonic election is predicated on the examiner having first made a telephonic restriction requirement. Where no telephonic restriction requirement was attempted, or was attempted without an election resulting, then as indicated by 37 CFR 1.142, the examiner will render "an Office action" and, pursuant to 37 CFR 1.143 and, in particular, the reference to 37 CFR 1.111 contained therein, an applicant must thereafter respond in writing. 37 CFR 1.104, last sentence, makes it clear that an Office action is not limited to patentability matters only, but may address matters of form and requirements of the regulations, e.g., restriction. And 37 CFR 1.111 makes it clear that a response to an Office action must be in writing.

While it is appreciated that the Office encourages telephonic elections, the condition precedent to such an election is clearly set forth in MPEP 812.01 as being an examiner initiated telephonic restriction. The record shows, paper No. 4, last sentence, that the examiner attempted to do this but the examiner's attempt did not result in an oral telephonic election. The examiner satisfied the requirements of MPEP §§ 812.01 and 713.04 by recording the unsuccessful attempt to obtain a telephonic election. Beyond that, it is not clear to the undersigned what relevance the interview practice discussed in MPEP § 713.04 has to the facts of this matter. While the examiner should have advised counsel that counsel's August 21, 2003 attempt to reply telephonically to a written restriction requirement did not satisfy 37 CFR 1.111 and 37 CFR 1.143, the examiner failure to do so does not relieve petitioner of the burden of complying with these regulations. The examiner is without authority to waive the regulations.

While it is noted that petitioner has argued that the oral election on August 21, 2001 should have been accepted as a *bona fide* attempt to respond to the restriction requirement, petitioner concedes that no written response to paper No. 4 was filed. In the absence of such a response, 37 CFR 1.135(c) does not apply, because 37 CFR 1.135 is, by its terms, limited to the failure of a reply to be "such complete and proper reply as the condition of the application may require." As the application contained a written restriction requirement, a written reply was required. 37 CFR 1.111 and 1.143. An oral response cannot be accepted as an incomplete written reply because an oral response not a written reply at all.

For the foregoing reasons, it does not appear that the examiner has acted in an arbitrary or capricious manner, or otherwise abused his discretion, in holding that this application stands abandoned for failure to file a timely and proper reply to paper No. 4. It appears, therefore, that there is no basis upon which to withdraw the examiner's holding of abandonment. Accordingly, this application is being forwarded to the Office of Petitions to consider the alternative relief requested under 37 CFR 1.137(b).

PETITION DENIED.

A handwritten signature in cursive script, appearing to read "E. Rollins-Cross", written over a horizontal line.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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